



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,892	11/17/1999	John S. Hendricks	5268	5151

38598 7590 08/24/2004

ANDREWS KURTH L.L.P.  
1701 PENNSYLVANIA AVENUE, N.W. SUITE 300  
WASHINGTON, DC 20006

EXAMINER

LANEAU, RONALD

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/441,892

Applicant(s)

HENDRICKS ET AL.

Examiner

Ronald Laneau

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective because: the applicants' signatures are missing.

Correction is required.

### ***Priority***

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-88 of this application. Applicant has claimed priority from application 07/991,074 filed on 12/09/1992, application 08/336,247 filed on 11/07/1994 now patent number 5,986,690, and application 08/160,194 filed on 12/02/1993 now patent number 5,990,927 which is a 371 of PCT/US93/11606 filed on 12/02/1993. However, applicant is not entitled to the priority of the cited application as they fail to provide adequate support for the claims in the present application. The new priority date for this application is from application 08/906,469 filed on 08/05/1997.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

Art Unit: 3627

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6-9, 13-21, 24-27, 29-36, 39, 40-45, 48-50, 54-62, 65-68, 70-77 and 80-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (US 5,799,157) in view of Westrope et al (US 5,721,832).

As per claims 1-3, 6, 19, 25-27, 30-36, 42-45, 50, 59, 60, 66-68, 75-77, 80, 82-86 and 88, Escallon teaches a method for providing electronic commerce using an electronic book, comprising: displaying an electronic book (fig. 1, 100); receiving a user's selection of the product or service (col. 3, lines 37-43) and a request to purchase the selected product or service (col. 4, lines 15-26); and performing a transaction to execute the purchase request (col. 5, lines 22-30).

Escallon does not teach presenting associated with the electronic book an identification of a product or service but Westrope et al teach a code transmitted by the terminals 63 or alternatively by utilizing a prefix or suffix number or alphanumeric associated with a particular system host site which in conjunction with the catalog product number uniquely identifies the site as an originator of a specific product or service order (col. 7, lines 60-65).

It would have been obvious to one of ordinary skill in the art to utilize the unique code or identification of a product or service order as taught by Westrope et al into the

Art Unit: 3627

device of Escallon because it would provide an electronic catalog process and system, which in turn provides efficient product and service selectivity to prospective customers.

As per claim 4, Westrope et al teach a method of payment over the telephone but neither Escallon nor Westrope et al teach electronically obtain payment for the product or service but it would have been obvious to one of ordinary skill in the art to utilize an electronic payment as claimed because it would allow a user to utilize the same terminal to complete the entire transaction so as to save time between transaction, the examiner takes the Official notice as such.

As per claims 6, 7, 47 and 48, Escallon teaches an apparatus wherein the module includes establishing an electronic communication with a web site for executing the purchase request as claimed (col. 5, lines 22-28).

As per claims 15-18 and 56-59, Westrope et al teach a recording module for recording statistical information concerning purchases of the product or service (see claim 8).

As per claims 20, 21, 61, and 62, Escallon discloses that some electronic catalog convey information about the products and their prices but does not disclose the steps of determining whether to accept the offered price and which criteria it was based upon but it would have been obvious to one of ordinary skill in the art at the time the invention was made to look for bargain such as discount, rebates on some of the products' offered prices as this becomes a norm now in the internet age for customers to book for the best available price or deal for a particular product, the examiner takes the Official notice as such.

Art Unit: 3627

As per claims 24 and 65, Escallon teaches a method wherein the displaying step includes displaying an hypertext link identifying the product or service and the receiving step includes receiving selection of the hypertext link as claimed (col. 3, lines 3-10).

As per claims 8 and 49, Escallon teaches a method wherein the presenting step includes displaying an icon identifying the product or service and the receiving step includes receiving selection of the icon by the user as claimed (col. 3, lines 37-43).

As per claims 40, 81 and 87, the examiner interprets the claimed sample section to be a small window like a pop-up ad in a section of the display screen. Escallon teaches displaying a product on the screen, which can be considered, to be a sample section capable of presenting a sample of the product as claimed.

6. Claims 10-12, 22, 37, 51-53, 64, 78 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (US 5,799,157) in view of Westrope et al (US 5,721,832) and further in view of Mital (US 5,903,652).

As per claims 10-12, 37, 51-53, 78 and 84, neither Escallon nor Westrope et al teach displaying an advertisement relating to the product but Mital teaches a computer system that can display advertisement relating to a product or service as claimed (col. 3, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the advertisement display as taught by Mital into the combined device of Escallon and Westrope et al because it would allow a user to click and display more information about the item being advertised on the display screen.

Art Unit: 3627

As per claims 22 and 63, neither Escallon nor Westrope et al teach an encryption module for encrypting the transaction for purchase execution of the purchase request but Mital teaches a computer system that sends a secure electronic message to a network service provider containing one or more transaction packets and an audit packet which are encrypted into two different encryption formats (col. 3, lines 48-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the encryption format as taught by Mital into the combined device of Escallon and Westrope et al because it would insure the security of the information being electronically transmitted over a network.

As per claim 64, neither Escallon nor Westrope et al teach an encryption module including a module for using a digital signature but the examiner takes the Official notice that a digital signature in electronic commerce is well known in the art because it would confirm at the other end that the right person has signed the document to authorize the transaction.

7. Claims 38, 46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (US 5,799,157) in view of Westrope et al (US 5,721,832) and further in view of Chelliah et al (US 5,710,887).

As per claims 38, 46 and 79, neither Escallon nor Westrope et al teach a digital coupon for use in purchasing the product or service but Chelliah et al teach the use of coupon for customer's discounts on a product or service as claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a coupon as taught by Chelliah et al into the combined

Art Unit: 3627

device of Escallon and Westrope et al because it would give more incentives to an on-line shopper to buy a particular product at discounted price.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wiecha (US 5,870,717) teaches a system for ordering items over computer network using an electronic catalog.
- Fortenberry et al (US 6,101,485) teach a method of engaging in electronic commerce over the internet wherein the steps of programming a first electronic mail (e-mail) message includes a description of at least one product available for sale by an electronic commerce (e-commerce) site.
- Joao (US 2002/0120635) teaches an apparatus and method for providing an electronic book.
- Joseph et al (US 6,606,603) teach a method and apparatus for ordering items using electronic catalogs.
- King, Jr et al (US 5,319,542) teach a system for ordering items using an electronic catalog

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.



Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Laneau  
Examiner  
Art Unit 3627

*Ronald Laneau* 8/19/04  
*Primary Examiner*

rl